

IN THE U.S. PATENT OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

BRIEF OF
APPELLANT RODGER BURROWS
UNDER 37 C.F.R 1.191

IN RE: The Application of:

INVENTOR: Rodger Burrows

GROUP ART UNIT: 3622

SERIAL NO.: 09/910,654

EXAMINER: Myhre, James W.

FILING DATE: 7/20/01

TITLE: **METHODS AND APPARATUS FOR ELECTRONICALLY
STORING TRAVEL AGENT COUPONS**

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The following brief is hereby submitted in accordance with 37 C.F.R. 1.191

1. REAL PARTY IN INTEREST

Rodger Burrows is the real party in interest.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

3. STATUS OF CLAIMS

Claims 1-18 are pending in the applications and are the subject matter of this appeal as follows:

Claim 1. Once amended in accordance with the amendment filed and mailed on July 7, 2003, stands rejected.

Claim 2. Unamended, stands rejected.

Claim 3. Unamended, stands rejected

Claim 4. Unamended, stands rejected.

Claim 5. Unamended, stands rejected.

Claim 6. Unamended, stands rejected.

Claim 7. Unamended, stands rejected.

Claim 7. Unamended, stands rejected.

Claim 9. Unamended, stands rejected.

Claim 10. Unamended, stands rejected.

Claim 11. Unamended, stands rejected.

Claim 12. Unamended, stands rejected.

Claim 13. Unamended, stands rejected.

Claim 14. Unamended, stands rejected.

Claim 15. Once amended in accordance with Appellant's communication of October 17, 2003 which was not entered by the Examiner in his communication of October 28, 2003. However, in the communication of 10/28/03, the Examiner stated that the amendment will be entered for purposes of appeal. Thus, unamended claim 15 stands rejected; and amended claim 15 is stated as would be rejected.

Claim 16. Original stands rejected. Cancelled for purposes of appeal.

Claim 17. Original stands rejected. Amended for purposes of appeal

Claim 18. Unamended, stands rejected.

4. STATUS OF AMENDMENTS

The amendment filed on July 17, 2003 was entered by the Examiner.

The amendment filed on October 17, 2003 comprising an amendment after under 37 C.F.R. 1.129 (a), was not entered by the Examiner in accordance with his communication of October 28, 2003. However, the additional documents disclosed on Form PTO 1449 were considered by the Examiner and made a matter of record. (these documents were previously submitted to the Patent Office on July 7, 2003 but not then made of record due to the non-submission of Form PTO 1449 by Appellant). The office communication of October 28, 2003 provided that the amendment of October 17, 2003 amending claims 15 and 17 and canceling claim 16 would be entered for purposes of this appeal.

5. SUMMARY OF THE INVENTION

The invention herein comprises methods and apparatus for electronically generating, storing, and retrieving airline agency ticket data whereby the data is simultaneously generated with the printing of an airline ticket, which data is then stored electronically in data storage apparatus in a director/directory/data file, the data being given an identifier, which data is thereafter retrieved and printed in a format of an agent coupon.

6. ISSUES

ISSUE NO.1

Whether the Examiner's rejection of claims 1-15 and 17-18 under 35 U.S.C. 102(f) because the Inventor Rodger Burrows did not invent the claimed subject matter was proper.

ISSUE NO. 2

Whether the Examiner's rejection of claims 1-15 and 17,18 under 35 U.S.C. § 103(a) over Friedes et al (5,521,966) in view of Industry Agent's Handbook (IAH), Section 70.0 (2000 Ed.) was proper

7. GROUPING OF CLAIMS

The claims of the group 1, 5 and 15, 17, 18 are separate groups that do not stand or fall together. Claims 1, 5 are method claims; claims 15, 17, 18 are apparatus claims. The Examiner cites only two references in combination to reject each group. However because of the different limitations in each group, the Examiner's statements of obviousness in making the combination are not equally applicable to each group.

8. ARGUMENT

- i.) The claims were not rejected under 35 U.S.C. 112, first paragraph; therefore, no argument is made in this regard.
- ii.) The claims were not rejected under 35 U.S.C. 112, second paragraph; therefore, no argument is made in this regard.

iii.) ISSUES

**(A) THE EXAMINER ERROUNOUSLY REJECTED
CLAIMS 1-15 and 17, 18 UNDER 35 U.S.C. 102(f).**

1) Brief Background

A brief summary of the relationship of the parties referred to in the documents submitted by Applicant and which form part of the record on appeal is deemed helpful to allow the board to fully consider the issues herein. This relationship summary is not new argument; all is contained within the submitted documents. Applicant is an individual who operates an independent travel agency. The Airline Recording Corporation (ARC) is an quasi independent organization funded by the airline industries that interfaces with independent travel agencies that issue airline tickets and from time to time issues policy statements intended to further the goals of the airline industry and provide uniformity to the issuing of airline tickets by the independent travel agencies and the records kept by the travel agencies. Thus, ARC may be said to be the policy arm of the airline industries vis-a-vis the independent travel agencies in the field of airline reservations, tickets, and associated records. Applicant does not work for ARC; rather Applicant is an independent travel agent

Another party reflected in the documents submitted by Applicant is the Travel Weekly News which is a weekly publication that reports on various travel related news, which news is accessible to the independent travel agencies. Upon information and belief, Travel Weekly News is a completely independent news organization. As further reflected in the submitted documents, the Travel News Weekly reports on Agent Issues which concern ARC's policies and requirements in general, and in particular, the subject matter of the invention herein.

In further of its goals , ARC issues an Industries Agent Handbook (IAH) that is required to be followed by the independent travel agents. . In accordance with the IAH, travel

agents are required to create and retain physical copies of an agent coupons for a minimum of two years. This requirement is stated in the application under the Description of the Prior Art. Further information of the data contained on the agent coupons and the requirement for the long time storage of the same is also recited in the application in the Description of the Prior Art.

2) The Examiner's Rejection Of Claims 1-15 and 17, 18 Under 35 U.S.C. § 102(f)

In the Office Action of 08/19/03, the Examiner rejected original claims 1-18 on the basis of 35 U.S.C. § 102(f) alleging that the Applicant did not invent the claimed subject matter. In support thereof, the Examiner stated:

As shown in the prior art submitted by the Applicant along with the Petition to Make Special, the Airlines Reporting Corporation (ARC) held meetings starting in 1999 to discuss removing the requirement for travel agents to store copies of agent coupons in either physical copies or on microfiche. During the September 29, 1999 Travel Distribution Task Force (TDTF) at the ARC Headquarters, it was disclosed that the ARC was "looking at the possibility of eliminating the requirement for agent retention of paper agent coupons" (page 3), that the "ultimate goal is to have a master storage database for these documents", and that "ARC would soon be allowing accredited entities to store these agent coupons on optical disc rather than paper" (page 4). During an October 27, 1999 press release, it was noted that the ARC management presented the Joint Advisory Board-Agent Reporting Agreement (JAB-ARA) "with draft text approving various media for electronic and optical storage of agent sales reports and supporting documents". This was further

reported in the November 1, 1999 issue of Travel Weekly, a travel industry publication, as a plan which “would eliminate one more piece of paper-the agent’s coupon” and that “Another option that the ARC is considering is to allow agents to keep their own electronic records to satisfy the two-year requirement to store agent’s coupons”. These plans evolved into an revised Industry Agent’s Handbook, Section 70.0, which stated that “an Agent may, upon prior written notice to, and written approval by ARC, maintain the required documents on microfiche or on an optical storage medium as specified below”...”must be copied to microfiche/film or to a non-magnetic optical medium that uses a “write-once, read-many” technology which will prevent overwriting the stored data (e.g. WORM technology). Certain non-volatile storage medium, such as CD-ROMs, optical disks, DVDs, and laserdiscs, may be determined to be acceptable storage media”. Finally, in the November 2, 2000 meeting of the Agent Working Group it was noted that “In June 2000, ARC made an announcement that IAR agents can now print agent coupon on non-accountable stock or capture the coupon data on an optical media (i.e. CD-ROM, DVD, etc.)”(emphasis added) and the “Agents now have the option to pursue the own agent coupon storage solutions.”

The present application and all of the claims are directed towards this new policy of the ARC, a policy which had been discussed at length in ARC and other travel industry meetings and publications for over a year before the priority date claimed by the Applicant. The Examiner also notes that the Applicant is not listed as an attendee in any of the meetings cited above. Thus, it appears that the Applicant has taken the advice of the ARC board and

it appears that the Applicant has taken the advice of the ARC board and developed a computer program to electronically store the agent's coupons. However, merely writing a program to implement another person's (or entity's) idea or a new law/requirement is not an inventive step.

Other than the Examiner's portrayal of the facts as recited above, the Examiner cited no law or authorities in support of his conclusion that Applicant did not accomplish "an inventive step".

In response to the Examiner's rejection of original claims 1-18, Applicant amended claim 1 in the communication of 07/08/03. The amendment to claim 1 consisted of adding the limitation "...in a format of an agent coupon" to the original limitation of "...retrieving said electronically stored agent coupon data and printing the same." There is no question of the claim amendment comprising new matter inasmuch as the original application on page 9, lines 19-25 there is described the ability to print an actual image of the agent coupon from the stored data.

In the final rejection dated 8/19/2003, the Examiner continued his basis of rejection of claims 1-18 under 102(f) without consideration of the amendment to claim 1.

**3) Applicant's Legal Argument In Opposition To The Examiner's Rejection
Of Claims 1-15 and 17, 18 Under 35 U.S.C. § 102(f)**

It is respectfully submitted that the amendment to claim 1 and the proposed amendment to claim 15 overcome the Examiner's rejection under 35 U.S.C. § 102(f). That is, that the limitations in claims 1 and 15, to the effect that the data associated with an agent coupon is simultaneously generated at the time an airline ticket is written, which data can

thereafter be used to generate an actual image of the agent coupon. Thus, the method of claim 1 and the apparatus of claim 15 do not provide for storing or capturing an image of the agent coupon. On the other hand, all of the documents relied on by the Examiner disclose that ARC had authorized that the agent coupons could be printed on non-accountable stock or that the actual image of the agent coupons could be saved by microfiche or on optical media. Nowhere in the documents did ARC authorize the storage of data rather than the actual image of agent coupons. Accordingly, it is not possible for ARC's disclosures to be considered the subject matter of Applicant's claimed invention.

As noted above, the basis of the Examiner's rejection under 35 U.S.C. § 102(f) is that ARC rather than Applicant invented the claimed subject matter. Under 35 U.S.C. § 102(f), a person is entitled to a patent unless he did not himself invent the subject matter sought to be patented. This is a derivation provision, which provides that one may not obtain a patent on that which is obtained from someone else whose possession of the subject matter is inherently prior. *Oddzon Products, Inc. v. Just Toys, Inc. et al.* 122 F.3d 1396 (Fed Cir. 1997). To prove derivation, the party asserting the derivation must prove both prior conception of the invention by another and communication of the conception to the patentee. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed Cir. 1997).

A rejection under 35 U.S.C. § 102 requires that each element or limitation of a claim must be found in a single source. This statement is well accepted and no citation of authority is necessary. In accordance with the Examiner's rejection as fully stated above, it is clear that the Examiner did not rely on one single source. Instead, the Examiner relied on a number of the separate documents by ARC and the Travel Weekly News. For this reason alone, the Examiner's rejection under 102 (f) is improper. However, without conceding the lack of a

single source requirement, it is respectfully submitted that Applicant's claimed invention as recited in claim 1 was not the subject matter of ARC's and the Travel Weekly News' prior disclosures, even if considered as a single source. In this regard, it is appropriate to review the disclosures of ARC and Travel Weekly News vis-a-vis claims 1 and 15. In reviewing the submitted documents which were relied on by the Examiner. It is most important to clearly understand the Examiner's position as to what ARC disclosed. The Examiner's position is most succinctly stated in the communication of 10/28/2003- "ARC discloses storing an agent coupon which has not been printed; thus. It cannot be storing an 'image' of the agent coupon, but only data which could be used to generate such a printed agent coupon". Thus, the issue under section 102(f) boils down to whether ARC disclosed the storage of an image of an agent coupon, or whether ARC disclosed the storage of agent coupon data which thereafter can be used to create an exact image of an agent coupon.

The most telling statement by ARC that storage of an optical image was required and not data storage, is the quote in the Travel Weekly News dated 6/20/2000 (doc. AM, Form PTO 1449), wherein Allan Muten, ARC corporate communications director is quoted as saying " If you're using a type of optical storage media, we're talking about capturing the image of the coupon, not creating a database."

In the September 29, 1999 (doc. 16, Petition To Make Special) meeting it was stated that ARC was looking into the possibility of eliminating the requirement for agent retention of paper agent coupons and that ARC would soon be allowing agencies to store these agent coupons on optical disc rather than paper. Again, the proposal being for an image of the agent coupons, and not data from the agent coupons.

In the October 27 1999 meeting (doc. 18, Petition To Make Special), ARC was asked to allow storage of agents' documents in formats other than microfiche/film or paper. In

response, ARC announced that it was permitting electronic storage of the coupon image as reflected in updated draft of section 70.0 of the Agents Handbook entitled Storage of Agents Sales Reports and Supporting Documents and Sales Summaries on Microfiche/Microfilm or other Optical Storage Media with the members. ARC then proceeded to review the updated draft with the members. As can be seen in the revised Agents Handbook, section 70.0, ARC changed the requirement to physically store agent coupons on accountable stock to either plain paper or by capturing the image of the agent coupon on microfiche or on optical media. But again, the actual image was required to be maintained on optical media as evidenced in paragraph (4) "the records which are stored optically ...must be direct, complete, and accurate reproductions of the originals..." An "accurate reproduction" can only mean an image and not data that is later used to generate an image.

In the Travel Weekly News dated 5/31/2000 (doc. AL, Form PTO 1449), ARC president David Collins is quoted as stating "Effective immediately, these agencies may print the agent's coupons on plain paper or capture the image on optical media, such as a CD-ROM.

In the Travel Weekly News dated 7/6/2000 (doc. AN, Form PTO 1449), it is stated that "ARC previously announced that agents who report sales electronically have the option of printing the agent's coupons of each ticket on non-accountable paper or capturing the image on optical storage media, effective immediately." In the same article of the Travel Weekly News, it was stated "In response to questions after the new policy was announced, ARC said it can give some advice but does not 'provide the tools or systems' to switch agent's coupons from accountable stock. Translation: It's up to the agents to figure out how to do it."

In the Sept 15, 2000 meeting (doc.13 ,Petition To Make Special), ARC asked if any vendors had the capability of optically storing agent coupon information, i.e. optically storing an image of the coupon

In the November 2, 2000 meeting (doc. 21, Petition To Make Special) ARC announced that as of June 7, 2000 can now print agent coupons on non-accountable stock or capture the coupon data on an optical media (i.e. CD-ROM, DVD etc.) And that Agents now have the option to pursue their own agent coupon storage solutions. Thus, the optical media storage that was allowed was for the storage of agent coupons themselves.

That ARC was still requiring the storage of images of the agent coupons is further reflected in the approval given to Applicants invention on January 19, 2001. In the January 19, 2001 document (doc. 22, Petition To Make Special), ARC stated "The agent coupons can be printed on demand and it is a facsimile of the agent coupon (I will fax you both a copy of the printed agent coupon.)" (Emphasis in the original) Thus, ARC was completely surprised that Applicant's invention could print an actual image from data and that Applicant's invention accomplished the complete elimination of agent coupons in deference to ARC's stated requirement to store an exact image of the agent coupon on an optical disc.

In accordance with the above, it is respectfully submitted that the construction of the one ARC statement emphasized by and relied on by the Examiner is misplaced. The totality of the ARC statements can only be viewed as ARC announcing a policy of requiring the storage of *the images* of the of the agent coupons on optical discs in lieu of the previous requirement of storing printed agent coupons and not the storage of *data* which thereafter can be used to print agent coupons on demand.. Accordingly., the Examiner has misstated the "new policy of ARC" and arrived at the erroneous conclusion that "Applicant has taken the advice of the ARC board and developed a computer program to electronically store the

agent's coupons.", which the Examiner characterizes as not being an "inventive step".

Applicant did not "merely write a program to implement another person's (or entity's) idea or a new law/requirement". Rather, Applicant invented a method whereby the storage of images of agent coupons is completely eliminated, as opposed to ARC's new policy of capturing the image of agent coupons on optical media.

It is therefor submitted that the Examiner's position of ARC disclosing the storing of the data of an agent coupon rather than an image of the same cannot stand.

Further, posing a problem does not constitute conception, *Morgan v. Hirsch* 728 F.2d 1449 (Fed. Cir. 1984). Inasmuch as ARC stated "In response to questions after the new policy was announced, ARC said it can give some advice but does not 'provide the tools or systems' to switch agent's coupons from accountable stock. Translation: It's up to the agents to figure out how to do it.", (Travel Weekly News dated 7/6/2000 (doc. AN, Form PTO 1449)), it is clear that ARC did not even conceive of its "advice" to optically store the image of agent coupons, but merely posed a problem to be solved. Since Applicant's invention solved a problem different from the problem stated by ARC, it was doubly improper for the Examiner to conclude that Applicant "had taken the advice of the ARC Board..."

In *Coleman v. Dines*, 754 F.2d 353 (Fed. Cir. 1985), the court held that to establish conception, a party must show possession of every feature recited in the claim (interference count) that the party disclosed to others in such clear terms as to enable one skilled in the art to make the invention. Here it is clear that the ARC Board did not show possession of the claim limitations to record data and generate an image from the data as accomplished by Applicant. Thus, it can not be said that ARC was in possession of Applicant's claimed invention and again did not conceive of Applicant's claimed invention. How else can ARC's statement "If you're using a type of optical storage media, we're talking about capturing the

image of the coupon, not creating a database.” be interpreted? It must therefore be concluded that ARC did not conceive of Applicant’s invention, and the Examiner’s rejection under 35 U.S.C. §102(f) is erroneous.

**(B) THE EXAMINER ERRONEOUSLY REJECTED
CLAIMS 1-15 and 17, 18 UNDER 35 U.S.C. 103.**

1) The Examiner’s Rejection Of Claims 1, 5, and 15, 17 and-18

The Examiner, in the first office action, rejected claims 1, 5 and 15, 17, 18 on the additional basis under 35 U.S.C. § 103(a) over Friedes et al (5,521,966) in view of Industry Agent’s Handbook (IAH, Section 70.0, 2000 Ed.). In this rejection the Examiner states that Friedes discloses a method and apparatus for generating airline tickets comprising each element of original claim 1. Then, the Examiner uses the IAH to note that ARC required the printing and storage of agent coupons as one of the documents along with an airline ticket, which the Examiner states that ARC in June of 2000 authorized the independent travel agents to print coupons on non-accountable stock or capture the coupon data on an optical media. Based on this combination the Examiner concludes that it is obvious to maintain the agent coupon data in Friedes as an electronic file available for retrieval and printing. The motivation being the revised IAH delineating the storage means. .

In response to Applicant’s amendment of Claim 1 (adding the limitation that the agent coupon is thereafter printed in the format of an agent coupon from stored data) the Examiner again rejected claim 1-18 as stated in the original rejection. The final rejection is submitted to be error for a number of reasons. The foremost being that the Examiner still maintained that ARC authorized and disclosed the electronic storage of agent coupon data rather than an

image of the coupon. Another reason being the assumption that agent coupons are involved in the transaction described by Friedes and therefore the teaching of Friedes is applicable to agent coupons (Friedes did not disclose or mention the agent coupons in the specification or claims, but, the Examiner assumed that the agent coupon data was in fact transmitted). In an attempt to further support the rejection under section 103, the Examiner discredited Applicant's image/data distinction by stating that ARC specifically directed the travel agents to develop their own systems to store the data, such as CD-ROMs, DVDs, hard drives, floppy discs, and others. The Examiner then argued that there is no reason why an image cannot be stored on a hard drive or any other storage medium. As shown below, the Examiner's 103 rejection is also erroneous.

2) Tests Under 35 U.S.C. § 103

Patent law recognizes that invention is generally the conception of a new combination of several old elements. Section 103 of the Patent Act incorporates this observation and provides that a patent may not be granted if the combination is considered obvious to a person of ordinary skill in the art of the subject matter of the invention. . See *Cases and Materials on Patent Law*, Second Ed., Thomson West, Ch. 7 (2003). While section 103 provides the basis for the issue of obviousness, the case law delineates the application of section 103 to actual inventions. The historical standard is found in *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1851); the modern standard is in accordance with *Graham v. John Deere Co.* 383 U.S. 1 (1956) and the cases following *Graham*. *Graham* announced the trilogy standard to be employed in determining obviousness under section 103: the scope and content of the prior art are to be determined, differences between the prior art and the claims are to be ascertained; and, the level of ordinary skill is to be resolved.

In this appeal, the prior art relied on by the Examiner comprise the Friedes reference and the IAH. The Examiner did not address the question of the level of ordinary skill; instead, the Examiner relied on the authorization by ARC to electronically store agent coupons, that the IAH discloses that the documents be stored, and that a PC and printer must be available to a representative of ARC where the optical copies are stored (office action of 5/1/2003). Applicant, on the other hand considered ARC to be one of ordinary skill (amendment dated 7/8/03), which was not objected to by the Examiner. In Applicant's amendments of 7/8/03 and 10/17/03, Applicant objected to the Friedes reference as being analogous art and that there were no suggestions or motivation to combine the cited references.

Under the two step test for determining whether a prior art reference is nonanalogous and thus not relevant in determining obviousness, it must be determined (1) whether the reference is within the field of the inventor's endeavor, and (2) if not, whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Deminski*, 796 F.2d 436 (Fed Cir. 1986). Whether something legally within the prior art is analogous is a fact question of the content of the prior art. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1987).

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 796 F.2d 1044 (Fed. Cir. 1988). Obviousness cannot be established by hindsight combination to produce the claimed invention; it is the prior art itself, and not applicant's achievement, that must establish the obviousness of the combination. *In re Dance* 160 F.3d 1339 (Fed. Cir. 1998). To prevent the use of hindsight to defeat patentability the Federal Circuit requires the

Examiner to show motivation to combine the references. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

3) Application Of The Law To The Facts of Applicant's Invention And The Examiner's 103 Rejection

a) The Friedes Reference Is Not Analogous Prior Art

The problem encountered and solved by Applicant is the ability to create a method and apparatus to eliminate the need to physically store printed agent coupons and to eliminate the need to electronically store the images of agent coupons as required by ARC as stated in the IAH. Inherent with to this problem was the need to retrieve an actual facsimile of the agent coupon on demand from a mass of stored data. Prior to applicant's invention, a separate document called an agent coupon was generated by travel agents at the time an airline ticket was issued and the printed agent coupon was required to be stored for a minimum of two years. Also prior to Applicant's invention, ARC announced a new policy whereby the actual image of the agent coupons could be stored on optical media such as microfiche, CD-ROMs, or DVDs in lieu of storing printed agent coupons. . ARC left it to the travel agents to determine how to optically store the actual image of the agent coupons. ARC made it perfectly clear that it's authorization was to store the image of the agent coupon and not the data associated with the agent coupons. Applicant's claimed invention is the storage of the data associated with agent coupons from which an actual facsimile of the agent coupons could be created on demand. In claiming his invention, the Applicant included the limitations of generating the data, identifying it, storing it, retrieving it on demand, and printing an actual image of the agent coupon from the stored data. .

The Friedes reference addresses the problem of increasing the uses of smart cards in accordance with data on the smart card and writing data onto the smart card. One such additional use disclosed by Friedes is to create a paperless system involving a transaction for purchasing of an airline ticket whereby no ticket in the form of a separate document, such as an e-ticket or an actual ticket, is generated. (Col. 7, lines 9-12). In accomplishing this new use, Friedes describes the transaction where a smart card user calls the telephone number of a smart card distributor. The user inserts his card in a reader/writer, selects the purchase of an airline ticket from a menu and is telephonically connected to a travel agent who is also connected to the system. The travel agent sends the flight information through the system, called a gateway, where the image of the smart card (not data) is maintained. The gateway records the flight information on the smart card. The user then withdraws the smart card. On arrival at the airport, the user presents his smart card to an attendant. The attendant inserts the smart card in another reader/ writer to verify the information and record the boarding. Thus, Friedes discloses a completely paperless system that stores the image of a smart card to conduct a transaction (it is to be noted that no printer is used or disclosed in Friedes). Can it therefore be said that the endeavors of Friedes and Applicant are within the same field? The mere fact that both Friedes' and Applicant's endeavors involve electronic storage and apply to an airline tickets does not mean that their respective endeavors are in the same field or even reasonably pertinent. Any two references can shown to have some similarities depending on how far back the association is made. No mention of an agent coupon or any other document associated with the purchase of an airline ticket is stated in Friedes because Friedes is a completely paperless system. No method of storing data and then be able to find and retrieve the data from a mass of stored data of other airline ticket transactions issued to other holders of smart cards is disclosed; rather, the flight data is written onto a particular smart card which

data is thereafter read directly from the particular smart card by a flight attendant.. Moreover, Friedes is directed to a single transaction. Applicant therefore fails to see how Friedes can be considered analogous prior art or art than can be considered pertinent to applicant's claimed invention. The Examiner merely assumes that an agent coupon is inherent in the smart card transaction because of the ARC requirements and that the storage requirements of agents coupons from all other ticket transactions is within the teachings of Friedes. Such assumption is not reasonable because Friedes discloses a paperless system where the printing of a document would be contrary to the accomplishment of Friedes. Even so, if any such assumption is to be made regarding Friedes, the only reasonable assumption is that the travel agent would need to electronically store an image of the agent coupons, which endeavor is not the same as Applicant's or reasonably pertinent thereto.

Accordingly, the test for analogous art stated in *re Deminski, supra* has not been established by the Examiner.

**b) There Is no Suggestion In Either Reference To Combine The
References**

It is clear that there is no suggestion in either the Friedes reference or the IAH reference to combine the two. The Friedes (1996) reference is concerned with paperless airline ticket in association with a particular smart card; the revised IAH reference (2000) is concerned with the storage of an image of many agent coupons, either a microfiche image or an optical image. Neither mentions the other. And even the assumption of the agent coupon being inherent in the Friedes reference as made by the Examiner, does not support any such suggestion. As fully explained above, Applicant stores data (not an image, compressed or otherwise) and generates the agent coupon itself from the stored data. No storage of agent

coupon data which can thereafter be printed in the format of an agent coupon is suggested by Friedes because it would defeat the entire thrust of his paperless invention. Conversely, storage of coupon data even if taught by Friedes, would be contrary to the requirements disclosed by ARC in the IAH to store the image of an agent coupon which thereafter can be printed. The suggestions gleaned from the cited references are therefore in opposite directions that together suggest not to combine the references. Thus, any such section 103 suggestion must stem from Applicant's invention and in accordance with *In re Rouffet, supra*, a hindsight suggestion must be shown by motivation.

In an attempt to show motivation, the Examiner stating it would be obvious for one of ordinary skill to maintain the agent coupon data in Friedes as an electronic file, available for retrieval and printing. The motivation to store the agent coupon electronically being in view of the newly revised IAH delineating the requirements for such storage means. In accordance with the above no such motivation can be possible because of the opposite teachings of the references, i.e. Friedes is directed to a completely paperless system not having any printing means, while the IAH is directed to storing an image for subsequent printing. In his motivation conclusion the Examiner again ignores the distinction that the "...IAH delineating the requirements for such storage means." requires the storing of an image and not data.

That no person having ordinary skill in the art would conclude that Applicant's claimed invention is obvious in consideration of the prior art comprising Friedes and the IAH is further shown by the surprise exhibited by ARC's Nancy Johnson in her letter of January 19, 2001 document (doc. 22), wherein she stated "...The agent coupons can be printed on demand and it is a facsimile of the agent coupon (I will fax you both a copy of the printed agent coupon.)"

Inasmuch as it has been thoroughly shown above, that the revised IAH only required the electronic storage of images of agent coupons (in lieu of printed coupons) and not the storage of data associated with agent coupons, it is submitted that the motivation relied on by the examine is erroneous. Thus, the Examiner's obviousness rejection of claims 1,5 and 15-18 cannot stand regardless of whether it is or it is not considered a hindsight determination.

c) The ARC Handbook Teaches Away From Applicant's Claimed Invention

One tool used to conclusively determine whether a § 103 rejection is applicable comprises the fact of the reference teaching away from the claimed invention. That the inventor achieved the claimed invention by doing what those skilled in the art suggested could not be done is a fact strongly probative of nonobviousness, *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed Cir. 1986). The closest reference would likely discourage the art worker from attempting the substitution suggested by the inventor, *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720 (Fed. Cir. 1990). In the present case, there is little doubt that the Applicant's invention is directed away from the teaching of the ARC references "If you're printing, you need to print the same information that would be on the agent's coupon. We (sic) not talking about selecting data elements, we're talking about [using a different] media." And "If you're using a type of optical storage media, we're talking about capturing the image of the coupon, not creating a database.", *ARC supra*. Thus, ARC's suggestion would have discouraged Applicant from inventing his combination. A further showing of ARC's teaching away and discouragement is reflected in ARC's approval letter of Applicant's invention, dated January 19, 2001 wherein Nancy Johnson exhibited amazement

of Applicant's accomplishment by a method directly contrary to ARC's revised IAH requirements..

4) The Rejection Of Claims 2-4 Under 35 U.S.C. § 103

Applicant incorporates all of his arguments stated in the arguments against claims 1, 5 and 15-18 by reference in this argument.

The Examiner basis his rejection of claims 2-4 by stating that while Friedes does not disclose a storage medium, the IAH discloses numerous storage media such as CD-ROM, optical discs, DVDs and other media such as a hard drive. The Examiner further states that even though ARC does not accept storage of agent coupon on hard drives, the disclosures teach the possibility of such storage. It is submitted that this rejection by the Examiner is also erroneous. No where in the ARC documents is it mention that the coupon image can be stored on a hard drive. The only media stated by ARC are optical i.e. CD-ROMs DVD's and laserdiscs. This is most understandable in that ARC required the image of the agent coupon to be stored and not data. Thus, the Examiner's rejection of claims 2-4 (and 5) is in error.

In this rejection, the Examiner refers to Friedes but does not rely on this reference. The Examiner only relies on the IAH. Therefore, there is no issue as to combining the references under section 103. For this independent reason, the Examiner's rejection of claims 2-4 cannot stand.

Claims 2-4 include the limitation of storing the agent coupon data and thereafter printing the data in the format of an agent coupon. Therefore claims 2-4 are also patentable under the well established principle that dependent claims that depend from allowable claims, are allowable regardless of the fact that the additional limitations of the dependent claims are known. Since Applicant has shown that claim 1 is patentable, claims 2-4 are also patentable.

5) The Rejection Of Claims 6-9 Under 35 U.S.C. § 103

Applicant incorporates all of his arguments stated in the arguments against claims 1, 5 and 15-18 by reference in this argument.

The Examiner basis his rejection of claims 6-9 under section 103 by stating that the IAH discloses a method for printing an airline ticket and Friedes discloses connecting the reservation apparatus with storage apparatus over switched networks. And that modems via the internet are obvious choices with the motivation being the to make a choice to limit or expand the range of agents who can access the system.

Since the Examiner stated a motivation for his combination of the references, he impliedly admits that the combination is made in hindsight. Thus, the question of the correctness of the Examiner's motivation is in issue in this grouping of claims. However such motivation does not exist in accordance with the incorporated arguments for claims 1, 5 and 15-18. Since claims 6-9 are dependent on claim 1, the limitations of claim 1 are present in claims 6-9, and therefore, the above showing of the error in the Examiner's motivation regarding claims 1, 5 and 15-18 is applicable to claims 6-9. But the Examiner did not incorporate his stated motivation of claims 1, 5 and 15-18 in this group of claims. By not incorporating the Examiner's stated motivation for claims 1, 5 and 15-18, he is estopped from rejecting claims 6-9 under section 103.

Claims 6-9 include the limitation of storing the agent coupon data and thereafter printing the data in the format of an agent coupon. Therefore claims 6-9 are also patentable under the well established principle that dependent claims that depend from allowable claims, are allowable regardless of the fact that the additional limitations of the dependent claims are known. Since Applicant has shown that claim 1 is patentable, claims 6-9 are also patentable.

6) The Rejection Of Claims 10-14 Under 35 U.S.C. § 103

Applicant incorporates all of his arguments stated in the arguments against claims 1, 5 and 15-18 by reference in this argument.

Since the Examiner stated a motivation for his combination of the references, he impliedly admits that the combination is made in hindsight. Thus, the question of the correctness of the Examiner's motivation is in issue in this grouping of claims. However such motivation does not exist in accordance with the incorporated arguments for claims 1, 5 and 15-18. Since claims 10-14 are dependent on claim 1, the limitations of claim 1 are present in claims 10-14, and therefore, the above showing of the error in the Examiner's motivation regarding claims 1, 5 and 15-18 is applicable to claims 10-14. But the Examiner did not incorporate his stated motivation of claims 1, 5 and 15-18 in this group of claims. By not incorporating the Examiner's stated motivation for claims 1, 5 and 15-18, he is estopped from rejecting claims 10-14 under section 103.

Claims 10-14 include the limitation of storing the agent coupon data and thereafter printing the data in the format of an agent coupon. Therefore claims 10-14 are also patentable under the well established principle that dependent claims that depend from allowable claims, are allowable regardless of the fact that the additional limitations of the dependent claims are known. Since Applicant has shown that claim 1 is patentable, claims 10-14 are also patentable.

CONCLUSION

In accordance with the above, Applicant has shown that the totality of the ARC documents, the IAH, and the Travel Weekly News documents support Applicant's position that ARC disclosed the storage of an image of agent coupons and not the data associated with agent coupons from which an actual image of the coupon can thereafter be printed on demand from a mass of stored data. Thus, Applicant has shown that ARC is not the inventor of Applicant's claimed subject matter. Applicant has further shown that the Friedes reference is not analogous prior art and even if it considered argument to be analogous prior art, the combination of Friedes and the IAH does not render obvious, under section 103, Applicant's claimed subject matter. The Board is respectfully requested to allow Applicant's claimed subject matter, including the unentered amendment to claim 15.

Respectfully submitted

A handwritten signature in black ink, appearing to read "R M Saccocio", with a large, stylized loop at the end.

Richard M Saccocio
Registration No. 26,800

Dated: January 14, 2004

In re The Application Of:

INVENTOR(S): Rodger Burrows

GROUP ART UNIT: 3622

SERIAL No.: 09/910,654

EXAMINER: Myhre, James W.

FILING DATE: 7/20/01

TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY STORING
TRAVEL AGENT COUPONS

APPENDIX

CLAIMS ON APPEAL

1. A method for electronically generating, storing, and retrieving airline ticket agency coupon data, comprising the steps of:

generating agent coupon data simultaneously with the printing of an airline ticket;

transmitting and storing said agent coupon data electronically to and in data storage apparatus;

providing each agent coupon data with an identifier;

storing said agent coupon data in a director/directory/image file arrangement; and

retrieving said electronically stored agent coupon data and printing the same in the format of an agent coupon.

2. The method of claim 1, including the step of storing said agent coupon data on a compact disk.

3. The method of claim 1, including the step of storing said agent coupon data on a hard drive.
4. The method of claim 1, including the step of transmitting and storing a plurality of agent coupon data in a batch file format.
5. The method of claim 1, including the step of generating said agent coupon data by airline ticket reservation apparatus.
6. The method of claim 5, including the step of serially connecting said reservation apparatus to said data storage apparatus.
7. The method of claim 5, including the step of connecting said reservation apparatus to said data storage apparatus by a modem.
8. The method of claim 5, including the step of internet connecting said reservation apparatus to said data storage apparatus.
9. The method of claim 5, including the step of intranet connecting said reservation apparatus to said data storage apparatus.
10. The method of claim 1, wherein said identifier comprises an ARC number.
11. The method of claim 10, wherein said identifier includes a sales period ending date.

12. The method of claim 11, wherein said identifier includes a ticket number.
13. The method of claim 12, wherein said identifier includes a passenger's name.
14. The method of claim 13, wherein said identifier includes a record locator.

15. Apparatus adapted to generate, transmit, store and retrieve airline agent coupon data, comprising:

airline ticket reservation apparatus; and,

data storage apparatus comprising:

a computer having a hard drive, said data storage apparatus being electronically connected to said reservation apparatus;

a software program means loaded in said computer for generating agent coupon data simultaneously with generation of an airline ticket, transmitting said agent coupon data to said computer, storing and retrieving said agent coupon data, on memory storage apparatus connected to said computer; and

printing means connected to said computer for printing said stored and retrieved agent coupon data in the format of an agent coupon.

17. The apparatus of claim 15, wherein said software program means further includes means for identifying each generated agent coupon data.

18. The apparatus of claim 17, wherein said software program means further includes means for filing each generated agent coupon data in accordance with said identifier means.